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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,385	11/16/2000	Nicholas J. Rush		8560
20350	7590	09/02/2004		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
			EXAMINER COBURN, CORBETT B	
			ART UNIT 3714	PAPER NUMBER

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,385

Applicant(s)

RUSH ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13, 16-30, 33-47 & 50-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingardt et al. (US Patent No. 5,275,400) in view of Walker et al. (US Patent No. 6086477). (Henceforth, Walker '477.)

Claims 1, 9, 20, & 37: Weingardt discloses a token account for tracking tokens associated with a first one of a plurality of players, (Col 7, 27-32) and a gambling apparatus coupled to the token account. (Col 7, 32-35) The apparatus is configured to debit or credit the token account based on the outcome of a gambling game. (Col 7, 43-49) There is a token conversion module for converting tokens according to a token value based on the total number of tokens in a set of tokens (i.e., pari-mutuel wagering). (Col 8, 3-10) The total number of tokens varies as more tokens that are bet. Weingardt discloses a computer system for implementing his invention. (Col 7, 26) Weingardt discloses that in bingo, it is well known to have a pool with a constant value (i.e., wherein a total value of all tokens in the set of tokens is constant) and wherein the total value of the tokens is derived from a source other than the players (i.e., is a cost of doing business). (Col 13, 55- Col 14, 2)

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Weingardt does not, however, teach the concept of a guaranteed win or statistically positive token return. Walker '477, an analogous invention, teaches that providing a guaranteed win increases participation in the game. (Col 3, 28-32)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a guaranteed win feature in Weingardt's pari-mutuel gambling method to increase participation in the game.

Claims 2, 21 & 38: Walker '477 describes a lottery system in which at least one token (a ticket) is selected and the player holding that token is awarded a predetermine prize. (Col 11, 56-65) Lotteries are an immensely popular form of gaming. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted Weingardt's pari-mutuel system to lotteries in order to take advantage of this popularity.

Claims 3, 22, 39: Weingardt discloses a method of determining the value of the token by dividing the value of the pari-mutuel pool by the number of outstanding tokens. (Col 12, 25-69) Weingardt also discloses that cash awards (the pari-mutuel pool) for Bingo are predetermined. (Col 13, 55-60)

Claims 4, 23 & 40: Weingardt discloses redeeming accrued credits. (Col 3, 39-40)

Claims 5, 24 & 41: Weingardt discloses that the pari-mutuel pool may comprise the set of all tokens awarded to all players. (Col 1, 39-41)

Claims 6, 25 & 42: Weingardt describes playing poker for table stakes. (Col 14, 60-64) When playing for table stakes, the set of tokens (money, chips, etc.) comprises the tokens awarded within a defined time limit – i.e., at the beginning of the game.

Claim 7: Weingardt discloses account initialization. (Col 7, 55-67)

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Claims 8, 26 & 43: Walker '477 discloses periodic drawings (Col 13, 1-2) and thus the conversion of tokens at the expiry of a predetermined time period – in this case, twice a week. Lotteries typically have periodic drawings and it would have been obvious to one of ordinary skill in the art at the time of the invention to have periodic lottery drawings to conform to customary practices in the industry.

Claims 10, 27 & 44: Weingardt discloses, sports betting on horse races (Col 1, 25-29), video poker (Col 3, 5), slot machines (Col 3, 12), blackjack, (Col 3, 12) and bingo (Col 13, 55). Walker '477 discloses a lottery game that is essentially keno. (Col 12, 63 through Col 13, 6). Weingardt discloses that pari-mutuel gambling may be used in connection with any number of games and that doing so would make the games comply with state and federal regulations. (Col 1, 13-20) While neither reference specifically teaches solitaire, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply pari-mutuel rules to that game to make it comply with state and federal regulation.

Claims 11, 28 & 45: Weingardt discloses various casino games. (Col 3, 5-13) Weingardt does not, however, teach the concept of a guaranteed win or statistically positive token return. Walker '477, an analogous invention, teaches that providing a guaranteed win increases participation in the game. (Col 3, 28-32)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a guaranteed win feature in Weingardt's pari-mutuel gambling method to increase participation in the game.

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Claims 12, 13, 29, 30, 46 & 47: Weingardt discloses conversion of tokens after a predetermined number of definable units of game play. (Col 7, 43-49) Weingardt discloses that after each hand or game, the amount of the player's winnings may be added to the credit meter. Players can cash out at any time. (Col 8, 3-10)

Claims 16, 33 & 50: Weingardt discloses a computer network. (Col 7, 22-26)

Claims 17, 34 & 51: While Weingardt discloses electronically linking the gaming devices in a conventional manner to a central computer, Weingardt does not specifically disclose use of the Internet. The Internet is, however, a well-known and conventional manner for linking computers. Walker '477 (Col 7, 57) discloses use of the Internet to link gaming devices with a central computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the Internet to link gaming devices to a central computer because this is a well-known and conventional manner of linking computers.

Claims 18, 35 & 52: Weingardt discloses a game machine. (Col 7, 14)

Claims 19 & 36: While Weingardt is primarily concerned with electronic gaming devices; it does discuss use of pari-mutuel wagering in traditional poker games in which there is a human dealer. (Col 14, 60-61)

Claims 53-55: Walker teaches that the source of gaming prizes may be one or more advertisers. (Col 2, 41- Col 3, 10) Having the prizes provided by one or more advertisers increases the profitability of the casino. Instead of having to fund the prize pool as a cost of doing business, the gaming establishment is relieved of that responsibility. This would tend to greatly increase profits. It would have been obvious to one of ordinary skill in the

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art at the time of the invention to have the source of the Weingardt's prize pool be provided by one or more advertisers (as suggested by Walker) in order to increase casino profitability.

Claims 56 & 57: Weingardt discloses a token account for tracking tokens associated with a first one of a plurality of players, (Col 7, 27-32) and a gambling apparatus coupled to the token account. (Col 7, 32-35) The apparatus is configured to debit or credit the token account based on the outcome of a gambling game. (Col 7, 43-49) There is a token conversion module for converting tokens according to a token value based on the total number of tokens in a set of tokens (i.e., pari-mutuel wagering). (Col 8, 3-10) The total number of tokens varies as more tokens that are bet. Weingardt discloses a computer system for implementing his invention. (Col 7, 26) Weingardt discloses that in bingo, it is well known to have a pool with a constant value (i.e., wherein a total value of all tokens in the set of tokens is constant) and wherein the total value of the tokens is derived from a source other than the players (i.e., is a cost of doing business). (Col 13, 55- Col 14, 2)

Weingardt does not, however, teach the concept of a guaranteed win or statistically positive token return. Walker '477, an analogous invention, teaches that providing a guaranteed win increases participation in the game. (Col 3, 28-32)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a guaranteed win feature in Weingardt's pari-mutuel gambling method to increase participation in the game.

Nor does Weingardt teach that the value of all tokens is derived from a source other than the provider of the game apparatus. Walker '477 teaches that the source of gaming prizes may be one or more advertisers. (Col 2, 41- Col 3, 10) Having the prizes provided by one or more advertisers increases the profitability of the casino. Instead of having to fund the prize pool as a cost of doing business, the gaming establishment is relieved of that responsibility. This would tend to greatly increase profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the source of the Weingardt's prize pool be provided by one or more advertisers (as suggested by Walker) in order to increase casino profitability.

3. Claims 14, 15, 31, 32, 48 & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingardt in view of Walker '477 as applied to claims 1, 20, & 37 above, (as appropriate) and further in view of Walker et al. (US Patent No. 6227972). (Henceforth, Walker '972.)

Claim 14, 31 & 48: Weingardt and Walker '477 disclose the invention substantially as claimed. Weingardt discloses token accounts lasting through multiple games or gaming sessions (Col 16, 17-23), but does not disclose an account that allows the player to leave the casino and come back at some later date. Walker '972, an analogous invention, discloses such an account and teaches that such accounts encourage repeat visits to the casino. (Col 3, 13-27) It would have been obvious to one of ordinary skill in the art at the time of the invention to provide accounts that allow the player to leave the casino and return at a later date in order to encourage repeat visits by the player.

Claims 15, 32 & 49: Weingardt and Walker '477 describe the invention substantially as claimed. These references do not, however, disclose the concept of expiring tokens.

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Walker '972 discloses expiring tokens. Walker '972 teaches that having expiring game tokens gives the player the incentive to make return visits to the casino. (See Abstract.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include expiring tokens in order to give players incentives to make return visits to the casino.

Response to Arguments

4. Applicant's arguments filed 6 July 2004 have been fully considered but they are not persuasive.

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Walker teaches a different definition of token than Applicant's. Applicant fails to address the contribution of Weingardt. Applicant must address the teaching of the combination as a whole.

Conclusion

6. This is an RCE of applicant's earlier Application No. 09/715,385. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cbc

JESSICA HARRISON
PRIMARY EXAMINER